INTERVIEW SUMMARY

Applicants thank Examiners Morris and Awad for the courtesies extended to Applicants' representative during an interview on February 24, 2010. During the interview, Applicants' representative and the Examiners discussed the Office Action including cited U.S. Patent No. 6,703,570 to Russell et al. ("*Russell*"). Applicants' representative explained why the claims distinguish over the cited references. The Examiners suggested clarifying claim amendments along the lines of those presented herein to further emphasize the differences. While Applicants do not believe the claim amendments presented herein are necessary to render the claims patentable, based on the interview and in order to expedite the application process, Applicants present amendments that further place the application in condition for allowance.

REMARKS

Applicants hereby cancel claims 18 and 19, and amend claims 1, 23, 30, 33, 34, 41, 45, and 51. Support for these amendments can be found, for example, at Figs. 1 and 3, and in the specification at page 3, line 32 through page 4, line 2, page 4, line 11 through page 5, line 19, page 7, line 29 through page 8, line 9, page 8, line 22 through page 9, line 9, page 9, lines 14-23, and page 9, line 26 through page 10, line 2. In the Office Action dated December 10, 2009, the Examiner rejected claims 1-16, 18-21, 23, 24, 26-38, 40-45, and 47-53 under 35 U.S.C. § 103(a) as being unpatentable over WO 01/48678 A1 to Andersson et al. ("*Andersson*") in view of *Russell*. The Examiner also rejected claims 17, 22, 25, 39, and 46 under 35 U.S.C. § 103(a) as being unpatentable over *Andersson* in view of *Russell* and further in view of U.S. Patent No. 6,958,747 B2 to Sahlberg et al. ("*Sahlberg*"). Applicants respectfully traverse these rejections.

§ 103 Rejection of claims 1-16, 18-21, 23, 24, 26-38, 40-45, and 47-53

Claim 1, as amended, recites an information processing system including, amongst other elements:

> an allocation unit configured to assign on command, from a position data bank, position data for a current graphical object, . . . **wherein the position data represents a plurality of optically-detectable marks;**

> . . ., wherein the allocation unit is commanded to assign the position data in response to a selection of the current graphical object, and **wherein the allocation unit provides said assigned position data to a combining module for printing** the user-readable graphic information corresponding to the current graphical object and **the plurality of optically-detectable marks on a substrate for forming a printed coded base.** (Emphasis added.)

In the Office Action, the Examiner concedes that "Andersson does not teach an allocation unit." Office Action at 3.

Russell, considered alone or in combination with *Andersson*, also does not teach or suggest a combination including the claimed allocation unit. *Russell* discloses a "digital pen that has a writing tip includ[ing] an ultrasonic (US) transducer on a pen body that generates frames of US pulses toward a receiver base in response to an infrared (IR) synchronizing signal from the base." *Russell* at Abstract, Fig. 1. *Russell* further discloses that the "base 16 can include one or more bar code readers 26" that "read bar codes on the substrate 12 to determine form or page number and positions of the fields 12a relative to the base 16" and thereby "processor 22 can determine a virtual location for virtual fields of the virtual counterpart to the actual form substrate 12." *Russell*, col. 4, ll. 59-65.

The Examiner cites to column 8, lines 1-26[1] of *Russell* as an alleged teaching of the claimed allocation unit. Office Action at 3. In the cited portion, *Russell* discloses:

> By means of reading the bar codes 109, the processor 22
> can determine not only the identity of the form, but also the
> position of the form substrate 12 relative to the base 16. . . .
>
> As mentioned above, the processor 22 also accesses a
> virtual copy of the form, stored in memory either concurrently
> with handwriting entry or post handwriting entry.
> Accordingly, when a user writes in an actual form field 108,
> the position of the writing is determined as described above
> and then associated with the position of the virtual
> counterpart of the field 108 and stored in memory. When the
> virtual copy of the form is to be printed, the handwriting, now
> digitized, is printed in the corresponding field.

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[1] Although the Office Action cites to column 18 of *Russell* (*see, e.g.,* Office Action at 3), *Russell* does not have a column 18. Examiner Morris explained in the February 24, 2010 interview that he intended to cite to column **8**, instead of column **18**.

As discussed in the interview, Applicants believe the Examiner is interpreting *Russell* to mean that the determination of the identity of a form or the position of a form substrate upon the reading of a bar code corresponds to the "on command" assignment of position data. However, *Russell* does not teach, or even suggest, "an allocation unit configured to assign on command, from a position data bank, position data for a current graphical object, . . . **wherein the position data represents a plurality of optically-detectable marks**. . . and wherein the allocation unit is commanded to assign the position data in response to a selection of the current graphical object" as recited in Applicants' claim 1, at least because the form and/or the position of a form substrate of *Russell* do not constitute "**position data** [that] **represents a plurality of optically-detectable marks**." Moreover, *Russell* does not teach or suggest an "**allocation unit** [that] **provides said assigned position data to a combining module for printing** the user-readable graphic information corresponding to the current graphical object and **the plurality of optically-detectable marks on a substrate for forming a printed coded base**" at least because the the form and/or position of the form substrate in *Russell* do not represent optically-detectable marks that are sent by an allocation unit to a combining module for printing to form a printed coded base.

Alternately, if the Examiner is interpreting *Russell* to mean that the determination of the position of a user's writing when a user writes in a form field corresponds to the "on command" assignment of position data, *Russell* still does not teach, or even suggest, "an allocation unit configured to assign on command, from a position data bank, position data for a current graphical object, . . . wherein the position data represents a plurality of optically-detectable marks . . . and wherein the allocation unit is

commanded to assign the position data in response to a selection of the current graphical object" as recited in Applicants' claim 1. This is at least because the handwriting of *Russell* and/or its position are **not** assigned "**in response to a selection of a current graphical object.**"

Moreover, although *Russell* discloses that a virtual copy of a form can be printed where handwriting is printed in a corresponding form field, col. 8, ll. 20-22, *Russell* does not teach, or even suggest, an allocation unit that "provides said assigned position data to a combining module for printing the user-readable graphic information corresponding to the current graphical object and the plurality of optically-detectable marks on a substrate for forming a printed coded base." This is at least because *Russell*'s identity of a form, the position of a form substrate, handwriting, and/or handwriting location, do not constitute a plurality of optically-detectable marks that are printed on a substrate for forming a printed **coded** base.

Thus, the Office Action has not properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and claim 1, as amended. Furthermore, the Office Action has failed to clearly articulate a reason why amended claim 1 would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for at least the reasons discussed above and Applicants request that the Examiner withdraw the rejection of independent claim 1 under 35 U.S.C. § 103(a).

The remaining independent claims (claims 23, 30, 33, 34, 41, 45, and 51), although each different in scope from claim 1 and from each other, are also amended and allowable for reasons similar to those discussed above in connection with claim 1.

Claims 23, 30, 33, and 34 have been amended to recite features similar to those discussed above in connection with claim 1, and thus, for reasons similar to those discussed above in connection with claim 1, *Andersson* and *Russell*, considered alone or in combination, do not teach or suggest the unique combination recited in claims 23, 30, 33, and 34. These claims are also allowable due to their recitations of other features not taught by the cited references.

Independent claims 41 and 45, as amended, recite methods of enabling, in an information processing system, printing on demand of one or more position-coded bases with graphical information thereon. Independent claim 41, as amended, recites:

> defining equal-sized units of a position area, the position
> area being a portion of a position code, **the position code
> including a plurality of optically-detectable marks**; . . .
> [and]
>
> assigning, on command in response to the selection of the
> graphical object, one unit of the position area for each
> physical page defined by the graphical object . . . (emphasis
> added)

Independent claim 45, as amended, recites:

> assigning, on command in response to the selection of the
> current graphical object, position data for the current
> graphical object from a position data bank, **the position
> data representing a plurality of optically-detectable
> marks** . . . (emphasis added)

For reasons similar to those discussed above in connection with claim 1, neither *Andersson* nor *Russell* teach or suggest assigning, on command in response to the selection of [a] graphical object, position data or a unit of a position area that is a portion of a position code, where the position data/position code represents (claim 45) or includes (claim 41) "a plurality of optically-detectable marks" as is recited in claims 41

and 45. Thus, the Office Action has not properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and claims 41 and 45, as amended. Furthermore, the Office Action has failed to clearly articulate a reason why these amended claims would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for at least the reasons discussed above and Applicants request that the Examiner withdraw the rejection of independent claims 41 and 45 under 35 U.S.C. § 103(a).

Similarly, independent claim 51 has been amended to recite a system for associating position data with graphical objects on a page, including, amongst other elements:

> a second memory containing position data to be assigned to at least some of the graphical objects, **wherein the position data represents a plurality of optically-detectable marks**;

> an interface configured to receive a user command selecting from the first memory at least one graphical object to which position data is to be assigned, the at least one graphical object characterized by user-readable graphic information and configured for application to a substrate; and

> a processor configured to assign position data from the second memory to the at least one graphical object in response to the selection by the user

As discussed above in connection with claim 1, neither *Andersson* nor *Russell*, considered alone or in any reasonable combination, teach or suggest the assignment of position data in response to a selection of a graphical object, where the position data represents a plurality of optically-detectable marks. Thus, *Andersson* and *Russell*,

considered alone or in combination, do not teach or suggest the unique combination recited in claim 51.

Accordingly, a *prima facie* case of obviousness has not been established with respect to independent claims 23, 30, 33, 34, 41, 45, and 51 for at least reasons similar to those provided above with respect to claim 1 as well as because these claims recite other features not taught nor suggested by the cited references. Therefore, Applicants respectfully request that the Examiner also withdraw the rejection of independent claims 23, 30, 33, 34, 41, 45, and 51 under 35 U.S.C. § 103(a).

Dependent claims 2-16, 20, 21, 24, 26-29, 31, 32, 35-38, 40, 42-44, 47-50, 52, and 53 depend from one of independent claims 1, 23, 30, 33, 34, 41, 45, and 51 and are at least allowable over the cited art based on their dependencies on allowable independent claims as well as because they cite additional features not taught or suggested by the prior art. Claims 18 and 19 have been canceled without prejudice or disclaimer, thereby rendering the rejection of those claims moot. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of the pending dependent claims under 35 U.S.C. § 103(a).

§ 103 Rejection of claims 17, 22, 25, 39, and 46

As discussed above in connection with claim 1, *Andersson* and *Russell* do not teach or suggest the unique combination including, amongst other elements:

> an allocation unit configured to assign on command, from a position data bank, position data for a current graphical object, . . . **wherein the position data represents a plurality of optically-detectable marks;**

> . . ., wherein the allocation unit is commanded to assign the position data in response to a selection of the current graphical object, and **wherein the allocation unit provides**

> **said assigned position data to a combining module for
> printing** the user-readable graphic information
> corresponding to the current graphical object and **the
> plurality of optically-detectable marks on a substrate for
> forming a printed coded base**. (Emphasis added.)

For similar reasons and those reasons discussed above, *Andersson* and *Russell* also

do not teach the allocation unit as claimed in claims 23, 34, and 45. *Sahlberg* does not

cure this deficiency. The Examiner has agreed with Applicants that *Sahlberg* does not

teach assigning position data on command. Office Action at 2.

As noted in connection with the earlier § 103 rejection, in order for an

obviousness rejection to stand, the Office Action must, yet has not, properly determined

the scope and content of the prior art and properly ascertained the differences between

the prior art and the claimed invention. Furthermore, the Office Action has failed to

clearly articulate a reason why claims 17, 22, 25, 39, and 46, which each depend from

one of claim 1, 23, 34, or 45, would have been obvious to one of ordinary skill in view of

the prior art. Therefore, a *prima facie* case of obviousness has not been established for

at least the reasons discussed above and Applicants request that the Examiner

withdraw the rejection of these dependent claims under 35 U.S.C. § 103(a).

Conclusion

The Office Action contains characterizations of the invention and the cited art

with which Applicants do not necessarily agree. Unless expressly noted otherwise,

Applicants decline to subscribe to any statement or characterization in the Office Action.

In view of the foregoing amendments and remarks, Applicants respectfully

request reconsideration and reexamination of this application and the timely allowance

of the pending claims.

Through this Amendment, Applicants have attempted to place this application in condition for allowance. If the Examiner foresees any impediments to allowance, the undersigned would welcome a phone call from the Examiner to resolve any outstanding issues.
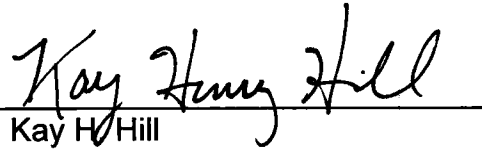
Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
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